

REMARKS

As a preliminary matter, the Office Action Summary indicates, “acknowledgement was made of a claim for foreign priority under 35 USC §§ 119(a)-(d) or (f)”, but “None of the copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau”. Applicants respectfully submit that the present application is actually a continuation of a PCT International Application designating the United States, and the application claims priority under 35 U.S.C. § 120 and 35 U.S.C. § 363. If additional documents are needed to perfect Applicants’ claim for priority, the Examiner is respectfully requested to notify Applicants.

Claims 1, 2, 5, and 6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended independent claim 1 as suggested by the Examiner to overcome the stated antecedent basis problem, and to define additionally that the washing process removes the lubricant not connected to the protection layer by immersing the magnetic recording medium in a solvent.

As to independent claim 5, the Office Action states that antecedent basis is lacking for the phrase “said lubricant which is not connected to said protection layer.” However, Applicants respectfully submit that this phrase does not appear in claim 5 or in dependent claim 6. Applicants have amended claim 5 to further clarify features of the present invention, and to the extent the 35 U.S.C. § 112, second paragraph rejection still applies to amended claim 5, Applicants respectfully traverse the rejection.

All of the stated indefiniteness problems are believed to have been addressed by the present amendments and remarks. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 1, 2, 5, and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin or Ishikawa in view of either Kazufumi or Ueda. As applied to the claims as amended, Applicants respectfully traverse the rejection.

Applicants wish to point out that, though the Office Action applies one or more combinations of references to reject claims 1, 2, 5, and 6, the Office Action does not appear to cite any of the (four) cited references as showing several significant features defined in these claims. Instead, the Office Action appears to rely on official notice to supply these features, and the overall inventive combinations, in the present rejection. However, Applicants respectfully submit that the conclusions made in the Office Action to supply these missing features appear to be based on impermissible hindsight. Furthermore, to the extent official notice is being relied on to reject the claims, Applicants respectfully traverse, and request citation of prior art supporting the assertions made.

Claim 1 and dependent claim 2 both define, among other features, the step of repeating a process to the protection layer plural times, where the process includes an application process of applying a lubricant to the protection layer, a subsequent UV process, and a subsequent washing process which removes the lubricant which is not connected to the protection layer by immersing the magnetic recording medium in a solvent. Applicants respectfully submit that neither Lin nor Ishikawa appears to disclose or suggest at least this washing process. As described in the present specification, a bonding sub-layer having a low

combination power with a protection layer of amorphous carbon is removed by the washing process. Accordingly, it is easy to combine a lubricant with a surface of the protection layer of the amorphous carbon because the lubricant is applied again. The Office Action appears to rely solely upon official notice to show this feature, and no suggestion within the references has been cited for modifying any of the individual references to provide the method defined in claims 1 and 2.

Furthermore, neither of the cited secondary references, Kazufumi or Ueda, appears to disclose repeating the three processes defined in claims 1 and 2. As also explained by the present specification, by repeating these processes, it is possible to reduce a ratio of a mobile sub-layer and increase a ratio of a bonding sub-layer by repeating one set of the three processes plural times. Again, the Office Action appears to rely upon official notice for motivation to modify Lin and Ishikawa to teach at least: repeating the process as claimed; adding at least the washing step; and repeating the washing step as part of the claimed repeated set. Applicants submit that these features, among other features, are neither shown nor suggested by the cited references, even when taken in combination.

Applicants further submit that the cited references, taken alone or in combination, also fail to show or suggest at least the features defined in claim 5 and dependent claim 6. Particularly, the references fail to teach or suggest at least the step of repeating a process to the protection layer of amorphous carbon plural times, where the process comprises an application process of applying a lubricant to the protection layer, and a subsequent UV treatment which connects a portion of the lubricant to the protection layer.

As provided in the present application, by repeating the application process and the subsequent UV treatment process, the mobile sub-layer changes to the bonding layer so that the ratio of the bonding layer is increased. See, for example, FIG. 6 of the present application. Applicants respectfully submit that none of the cited references, alone or combination, appears to disclose or suggest at least this step, and further that the Office Action appears to rely upon official notice for a motivation to modify Lin or Ishikawa to teach this defined step.


For at least these reasons, Applicants respectfully submit that claims 1, 2, 5, and 6 as amended are allowable over the references of record, including Lin, Ishikawa, Kazufumi, and Ueda. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

For at least the foregoing reasons, Applicants believe that this case is in condition for allowance, which is respectfully requested. The Examiner should call Applicants' attorney if an interview would expedite prosecution.

Respectfully submitted,

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July 9, 2003

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